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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,335	09/24/2003	Jim Dumont	P18003US1	4410

7590

08/23/2005

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EXAMINER

CAI, WAYNE HUU

ART UNIT

PAPER NUMBER

2681

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,335

Applicant(s)

DUMONT ET AL.

Examiner

Wayne Cai

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-12 is/are rejected.
- 7) ☒ Claim(s) 2-5, 13-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/24/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because these drawings are not formal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 6-7, 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Okuyama (US 2001/0005859 A1).

Regarding claims 1, 7, and 12, Okuyama discloses a method, and a communication system for sending a message notification to a recipient of a message, the method comprising the steps of:

a) upon receipt of a message destined to a recipient at a first server, determining whether or not a notification is to be sent to the recipient for alerting of the presence of the message at the first server (paragraphs 0113-0117, and 0130);

b) based on a result of step a), selectively inserting in a copy of the message that is to be forwarded by the first server to a second server an indication representative of whether or not a notification has been sent to the recipient of the message (paragraphs 0027-0028);

c) transmitting the copy of the message with the indication from the first server to the second server (paragraphs 0027-0028).

Regarding claims 6, and 11, Okuyama discloses the method, first server claimed in claims 1, 7. Okuyama also discloses wherein the determination related to whether or not a notification is to be sent to the recipient for alerting of the presence of the message is based on settings internal to the first server (fig. 1, elements 8, 10, and 11 and its descriptions).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama.

Regarding claim 8, Okuyama discloses first server claimed in claims 1, 7, and 12 except for disclosing wherein the notification to the recipient is a message selected from the group of messages consisting of: a Short Message Service (SMS) message,

and Enhanced Messaging Service (EMS) message, a Multimedia Messaging (MMS) service, and a direct HTTP Push message. However, it is well known in the art and it is also discussed in the instant application (see pages 1-5 of the specification).

6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama in view of Sar-Shalom (US 2004/0267884 A1).

Regarding claim 9, Okuyama discloses first server claimed in claim 7. It is also well known in the art that the message is a Multimedia Messaging System (MMS) message; the first server is an MMS Center (MMS-C) server; and the second server is a Value Added Service Provider (VASP) server, except for the MMS message is forwarded from the MMS-C to the VASP based on a detected condition for forwarding.

In a similar endeavor, Sar-Shalom discloses an automatic messaging client launcher for a communication device. Sar-Shalom also discloses wherein the MMS message is forwarded from the MMS-C to the VASP based on the detected condition for forwarding (paragraphs 0009-0014, figs 1 & 2 and its descriptions).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the step of forwarding messages based on the condition so that only desired messages are forwarded.

Regarding claims 10, Okuyama discloses first server claimed in claim 7, except for the detected condition for forwarding comprises an automatic forwarding feature activated by the MMS message recipient.

In a similar endeavor, Sar-Shalom discloses an automatic messaging client launcher for a communication device. Sar-Shalom also discloses wherein the detected condition for forwarding comprises an automatic forwarding feature activated by the MMS message recipient (paragraphs 0036-0038).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the step of activating the forwarding by the recipient so that the message is forwarded to an alternative destination as desired as if the recipient is not available at the moment.

Allowable Subject Matter

7. Claims 2-5, and 13-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Tenhunen (US 2005/0033852 A1)
- b. Parsons et al (US – 6,871,214 B2)


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Cai whose telephone number is (571) 272-7798.

Art Unit: 2681

The examiner can normally be reached on Monday-Friday; 9:00-6:00; alternating Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Wayne Cai
Examiner
Art Unit 2681


ERIKA A. GARY
PRIMARY EXAMINER